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| 10/600,011 | 06/19/2003 | Birgit Byman-Kivivuori | NOKV.013CIP | 6004 |
| 76385 7590 01/09/2009 Hollingsworth & Funk, LLC 8009 34th Avenue South Suite 125 Minneapolis, MN 54425 | | | | |
| EXAMINER | | | | |
| SMITH, CREIGHTON H | | | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/600,011

Applicant(s)

BYMAN-KIVIVUORI ET AL.

Examiner

CREIGHTON SMITH

Art Unit

2614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 NOV '08.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14, 16, 18, 20-24, 26-50 is/are rejected.
- 7) ☒ Claim(s) 15, 17, 19 and 25 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 3, 4, 5, 9, 11, 13, 16, 20, 21, 23, 25, 26, 28, 29, 35, 36, 38-50 are rejected under 35 U.S.C. 102(E) as being anticipated by Petrovich, U.S. Patent Publication #2004/0147270.

Examiner disagrees with applicant's arguments filed on 26 NOV '08 that Petrovich does not disclose a visual representation for the user identifying a function that is to be performed. Petrovich discloses in P.0008 that signs include machine-readable dataforms that the customer can scan. The dataform may be placed next to generically descriptive text on the sign. The sign may also include readable dataforms or services offered for further information. The sign can further include a logo or emblem that provides easy viewing by the customer such that the logo indicates the associated product or service that is being offered. These signs with their logos, emblems, or text are the visual representations that leads the customer to further inquire about the product/service that is being offered via RFID. In P.0009 Petrovich discloses that the logo/symbol causes the customer to be made aware of the store's promotion through the readable dataform. Fig. 13 of Petrovich shows the visual representations such as

"chips," "cola," "cookies," "bread." Also see P.0065 where Petrovich specifically discloses the phrase "visual means."

Examiner disagrees with applicant's arguments that Petrovich does not teach that the function to be performed is represented by the visual image. Petrovich's dataform (106) reads upon applicant's recital of "the function" because in P.0030 Petrovich discloses a transaction terminal is approached by a customer, which terminal includes a readable dataform that is read by the customer's m-commerce device. Once a customer's m-commerce device scans the dataform, Petrovich discloses, an association is made between the customer and the terminal, and info is transmitted from the device to a location address of POA terminal 104 such that POA data of the customer stored in the customer's m-commerce device is presented to the customer at the at the POA terminal. Therefore, the "function to be performed" reads upon Petrovich's transferring of data to the POA terminal where the customer and her m-commerce device are located and requesting additional info.

Petrovich teaches a system and method for initiating services with a mobile device. The mobile device is shown in Figs. 14A, 14B and 102 – Fig. 1. Petrovich discloses in ¶-0008 that signs are provided that have machine-readable dataforms embedded with them so that a customer can scan with her m-commerce 102 device. The dataform may be placed next to descriptive text on the sign, with the sign placed next to the product. Petrovich goes on to disclose that the sign may contain a logo or emblem that provides for easy viewing by the customer, with the logo indicating the associated product/service being offered. In ¶-0009 Petrovich discloses that the readable

logo/emblem contains the readable dataform. In ¶-0006, Petrovich discloses that the m-commerce device includes a device reading apparatus that will read a dataform. A terminal 104 provides interactive presentation to the user, with the m-commerce device 102 (applicant's mobile user device) and terminal 104 in wireless communication. When the user causes the m-commerce device to read a terminal's dataform, item information input and stored in the m-commerce device is transmitted wirelessly to the terminal for interactive presentation to the user. In ¶-0028 Petrovich discloses RFID to get the data from the terminal 104 to m-commerce device, and in ¶¶-0031, 0052, and 0072 that the dataform 106 may be a code embedded in a transponder system such that proximity of mobile device 102 to terminal 104 triggers automatic activation of the transponder system to expose the encoded dataform code to the receiving system. In claim 34 Petrovich discloses that the dataform is encoded with the transponder in association with the RFID system.

Therefore, Petrovich discloses applicant's transponder having information (the dataform) associated with it, and also meets applicant's "associating" step because the visual information in the form of a sign (¶-0008) is in close proximity with a dataform and transponder. Applicant's "activating" step is met by Petrovich in ¶-0072.

In ¶-0035 Petrovich discloses, last sentence, that customer 100 controls device 102 such that the dataform 106 can be read. Once the dataform 106 is read, the device 102 automatically operates to format and transmit data therefrom. Therefore, when Petrovich transmits the data from the m-commerce mobile device, the mobile device is invoking some type of application to wirelessly transmit the data that it received the

dataform/transponder. In ¶-0037 Petrovich discloses that transmission of the dataform occurs over wireless link (110) to a network interface (112), such as an IEEE 802.11b device (WLAN) located in the store. Some of the types of wireless technologies that can be used are RF and BLUETOOTH™. Both RF and BLUETOOTH are applications.

For claim 3, Petrovich discloses in P.0029 that RFID comprises small data-carrying tags, and those tags are embedded in objects to be identified. Therefore, applicant's "visual representation associated with a transponder" is met by Petrovich's "tags embedded in objects to be identified."

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Petrovich in view of Forster et al, U.S. Pat. App. Pub. #2002/0177408.

Forster et al disclose in P.0050 a transponder 30 that may contain its own power source, such as a battery, or other energy storage unit. To have provided Forster et al teaching of a transponder having its own power source into Petrovich transponder would have been obvious to a person having ordinary skill in the art.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Petrovich in view of Heinrich et al, U.S. Pat. App. Pub. #2003/0017804.

Heinrich et al disclose in P.0004 that an RFID tag will transmit stored data by backscatter modulation. To have used Heinrich et al backscatter modulation technique

to transmit stored data in Petrovich's transponder would have been obvious to a person having ordinary skill in the art.

Claims 2, 6-8, 14, 24, 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Petrovich in view of Lachance, U.S. Pat. # 6,246,882.

Lachance discloses in Fig. 2 and col. 3, lines 23 et seq. that data communications in a wireless network may consist of Short Message Service, SMS. Later in col. 3, lines 40 et seq. Lachance discloses that the wide area tracking system 2 uses a cellular network 10 combined with a radio frequency ID device 36 and that cellular network 10 could comprise SMS. To have incorporated Lachance's disclosure of using SMS in his RFID units to communicate in the cellular network, and used that technology in Petrovich's system would have been obvious to a person having ordinary skill in the art, because the skilled practitioner with these 2 references in front of her, both utilizing RFID to communicate, would have found the SMS communication application substitutable in Petrovich's system. Common sense would dictate this substitution. Regarding claims 6-8, applicant's application identifier reads upon Lachance's SMS.

Claims 18, 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Petrovich in view of Domnitz, U.S. Pat #6,912,398.

Domnitz discloses in his Abstract a time/location information delivery system that provides information to individuals based on the time and their location. A wireless ID device is carried by an individual and can be read from or written to when the individual passes the interrogators in a specific geographic location. The detectors read ID info

embedded in the wireless ID device. A computer then will use the ID and location info to select those info providers which is of interest to the individual. The information content can be forwarded to the individual by a variety of info channels. One channel uses Internet email to deliver info to the individual's Internet mailbox. Later in Abstract Domnitz discloses that the wireless ID device is an RFID tag embedded in a card, or even in a wireless phone (see Fig. 3). In col. 7, lines 32 et seq. Domnitz discloses that wireless phone 11 can receive the info through their web browser which allows them to surf the web, receive email, etc. Domnitz's advertising system 7 can use the Internet to contact to contact mobile phone 11. In col. 10, lines 49-50 Domnitz discloses that a URL or web page can then be loaded to the users account using the above outlines system. To have provided Domnitz URL and web browser technology into Petrovich's wireless information delivery system would have been obvious to a person having ordinary skill in the art because both references are teaching communicating via RFID technology and common sense would dictate to the skilled artisan to substitute one reference's teaching into the other reference. For claim 37, Domnitz discloses PDA 9.

Claims 30-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Petrovich in view of Heinrich et al and Lachance.

Claim 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over Petrovich in view of heinrich et al and Lachance as applied to claim 30 above, and further in view of Domnitz..

Claims 15, 17, 19, 25 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication should be directed to Creighton H. Smith at telephone number 571/272-7546.

05 JAN '09

/Creighton H Smith/
Primary Examiner, Art Unit 2614